



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/753,288	11/22/96	BATTIATO	D L-F/168

THOMAS W HUMPHREY
WOOD HERRON & EVANS
2700 CAREW TOWER
CINCINNATI OH 45202

QM31/0624

P

EXAMINER	
FINKEL, S	
ART UNIT	PAPER NUMBER
3734	5

DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/753,288

Applicant(s)
Battiato et al.

Examiner
Sharon Finkel

Group Art Unit
3734



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 0 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-38 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☐ Claim(s) _____ is/are rejected.

☐ Claim(s) _____ is/are objected to.

☒ Claims 1-38 are subject to restriction or election requirement.

Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

Art Unit: 3734

Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
2. This application contains claims directed to the following patentably distinct species of the claimed invention:

Species Group 1, claims 1-7, directed to an injector having a control circuit responsive to air detection means;

Species Group 2, claims 11-20, directed to an injector having a control circuit responsive to hand-operated movement control;

Species Group 3, claims 21-26, 28-30 and 32, directed to an injector having a control circuit responsive to an electronic display of information which is in turn responsive to a tilt angle sensor;

Species Group 4, claims 27 and 31, directed to an injector having a control circuit responsive to an electronic display of information which is in turn responsive to a tilt angle sensor and the control circuit is also responsive to hand-operated movement control;

Species Group 5, claim 33, directed to an injector having a control circuit responsive to a face plate mounting and face plate mounted thereon, and the magnetic fields generated thereby;

Species Group 6, claims 34-38, directed to an injector having a control circuit responsive to hand-operated movement control and an encoder controlling the motor on said plunger drive.

Art Unit: 3734

3. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, no claim is generic. For clarification, the following elements are deemed to be generic to all claims listed above: plunger drive ram, motor for moving said plunger drive ram, syringe, and control circuit.
4. Applicant is advised that a response to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.
5. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).
6. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Art Unit: 3734

7. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

8. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

9. The following additional restriction is required under 35 U.S.C. 121

Group I. Claims 1-7, drawn to an injector with an air detector for detecting the presence of air contained in a syringe, a warning signal and a circuit responding to the warning, classified in class 604, subclass 122.

Group II. Claims 8-10, drawn to a syringe having an means (lens) for detecting air in the syringe, classified in class 604, subclass 122.

10. The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the air detector


Art Unit: 3734

as claimed can detect air anywhere "contained within said syringe", and the syringe has an "outwardly-projecting section positioned on the discharge tip." The subcombination has separate utility such as providing means for the detection of air or medicine entering the needle by manual methods (by eye), to assist in the proper filling of the syringe.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sharon Finkel whose telephone number is (703) 305-0154.


sef

June 15, 1998


RONALD STRIGHT
PRIMARY EXAMINER